

Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 0951-0132P																			
	Application Number 10/806,109-Conf. #1859	Filed March 23, 2004																			
	First Named Inventor Masatsugu MASUDA et al.																				
	Art Unit 2814	Examiner Wai-Sing Louie																			
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <table><tr><td><input type="checkbox"/></td><td>applicant /inventor.</td><td><u>Robert Drane #48,222</u></td><td>Signature</td></tr><tr><td><input type="checkbox"/></td><td>assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</td><td>Terrell C. Birch</td><td>Typed or printed name</td></tr><tr><td><input checked="" type="checkbox"/></td><td>attorney or agent of record. Registration number 19,382</td><td>(703) 205-8000</td><td>Telephone number</td></tr><tr><td><input type="checkbox"/></td><td>attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____</td><td>September 17, 2007</td><td>Date</td></tr></table> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <table><tr><td><input type="checkbox"/></td><td>*Total of 1 forms are submitted.</td></tr></table>				<input type="checkbox"/>	applicant /inventor.	<u>Robert Drane #48,222</u>	Signature	<input type="checkbox"/>	assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)	Terrell C. Birch	Typed or printed name	<input checked="" type="checkbox"/>	attorney or agent of record. Registration number 19,382	(703) 205-8000	Telephone number	<input type="checkbox"/>	attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____	September 17, 2007	Date	<input type="checkbox"/>	*Total of 1 forms are submitted.
<input type="checkbox"/>	applicant /inventor.	<u>Robert Drane #48,222</u>	Signature																		
<input type="checkbox"/>	assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)	Terrell C. Birch	Typed or printed name																		
<input checked="" type="checkbox"/>	attorney or agent of record. Registration number 19,382	(703) 205-8000	Telephone number																		
<input type="checkbox"/>	attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____	September 17, 2007	Date																		
<input type="checkbox"/>	*Total of 1 forms are submitted.																				

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Masatsugu MASUDA et al.

Application No.: 10/806,109

Confirmation No.: 1859

Filed: March 23, 2004

Art Unit: 2814

For: ELECTRONIC EQUIPMENT, BACKLIGHT
STRUCTURE AND KEYPAD FOR
ELECTRONIC EQUIPMENT

Examiner: Wai-Sing Louie

REASONS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

MS AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In addition to the Notice of Appeal which is being concurrently filed, Applicants respectfully request a Pre-Appeal Brief Conference to consider the issues raised in the Office Action dated May 16, 2007, that finally rejected claims 1-4, 10, 24, 25, 28, 32, 33, and 35.

Rejection Under 35 U.S.C. § 103

The Examiner has rejected claims 1-4, 10, 24, 28, 32, 33, and 35 under the provisions of 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,083,240 (Pasco) in view of U.S. Application Publication 2003/0117794 (Lu). The Applicants respectfully submit that the rejection fails to establish prima facie obviousness for claims 1-4, 10, 24, 28, 32, 33, and 35. For a Section 103 rejection to be proper, the cited reference must teach or suggest all the claim limitations. *See M.P.E.P. §§ 2142, 2143.03*. Thus, if the cited reference fails to teach or suggest one or more limitations, then the rejection is improper and must be withdrawn. The Applicants

respectfully submit that Pasco and Lu, either alone or in combination, fail to disclose all claimed limitations.

The Claimed “detachable” Feature is a Structural Limitation that must be Given Patentable Weight

Claim 1 recites, among other things, “at least one light source” and “a region that contains phosphor, which is separate from the light source.” Furthermore, the claim recites the feature of “wherein said at least one light source is detachable from the region that contains phosphor.”

In the Final Office Action, the Examiner states that the feature of “wherein said at least one light source is detachable from the region that contains phosphor” is an intended use of a device. Applicants had argued that this feature is not an intended use, but rather a structural feature of the light source and the region that contains phosphor. For example, if the phosphor is part of the material that makes up the light source, which is typically the case, then the region that contains phosphor cannot be detached from the light source. Furthermore, a structure of color-shift medium formed on the backlight by a wet coating process or a dry deposition process of Lu are processes that do not intend detachment.

In an Advisory Action mailed August 1, 2007, the Examiner alleges that,

“the phosphor is contained in the light guide (not in the light source as shown in fig. 2). The claim should be held as enablement in the present form.”

With regard to the statement in the advisory action that the claim should be held as enablement, Applicants submit that raising an enablement issue constitutes a new ground of rejection, not necessitated by amendment, and does not address arguments regarding the rejection based on prior art.

Furthermore, present fig. 2 does not show phosphor contained in the light source. Rather, a region containing phosphor 204 is located in the vicinity of keytop 203a. The light source, LED 102, is separate from the waveguide 203, region containing phosphor 204 and keytop 203a, as is clearly shown in the drawing. This is consistent with the claim which recites “a region that contains phosphor, which is separate from the light source.”

In a subsequent Advisory Action mailed August 18, 2007, the Examiner appears to elaborate on the reason that the claim allegedly has an enablement issue, by stating that,

in addition to the feature of at least one light source that is detachable from the region that contains phosphor, the claim also recites “the phosphor is for emitting visible light.” The Examiner concludes that “the light source and the phosphor are in-separable and the statement, “the at least one light source is detachable...” does not make sense.”

Again, Applicants submit that raising a clarity and/or enablement issue does not address arguments regarding the rejection based on prior art.

Furthermore, claim 1 recites that “a region that contains phosphor...for emitting visible light by being excited by the light from the light source.” Applicants submit that the claim is clear in that the region that contains phosphor is excited by light from the light source, which does substantiate the feature of a light source that is separate from the region that contains phosphor. Also, it is noted that the claim does not recite that a detached region that contains phosphor emits visible light, as may be implied by the Examiner’s comments.

In addition, Applicants had argued that if it were true that the claimed feature of “wherein said at least one light source is detachable from the region that contains phosphor,” is intended use, the resulting structural difference must be evaluated (the topic of “intended use” is discussed in M.P.E.P. § 2111.02), not ignored as was done in the Final Office Action.

Similar arguments were made for claim 24.

Accordingly, Applicants request the claimed “detachable” feature be given patentable weight as being a structural limitation, and request that the rejections based on prior art be reconsidered and withdrawn.

Applicants respectfully submit that that independent claims 1 and 24 are patentable, and are allowable over the prior art of record.

Dependent Claims 2-4, 10, 28, 32, 33, and 35

Claims 2-4, 10, 28, 32, 33, and 35 are dependent claims which depend from independent claims 1 and 24. It is respectfully submitted that claims 2-4, 10, 28, 32, 33, and 35 are allowable over the prior art of record for at least the same reasons as claims 1 and 24.

Conclusion

In view of the above remarks, it is believed that claims are allowable.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Robert W. Downs Reg. No. 48,222 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

Dated: September 17, 2007

Respectfully submitted,

By Robert Downs # 48, 222
Terrell C. Birch

Registration No.: 19,382

BIRCH, STEWART, KOLASCH & BIRCH, LLP

8110 Gatehouse Road

Suite 100 East

P.O. Box 747

Falls Church, Virginia 22040-0747

(703) 205-8000

Attorney for Applicant